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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/781,587

02/17/2004

Phil Dean Roberts

Surf Sculpture

3404

7590

06/02/2006

EXAMINER
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WOLLSCHLAGER, JEFFREY MICHAEL

Eric Hanscom

Suite 204

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Carlsbad, CA 92009

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/781,587	<b>Applicant(s)</b> ROBERTS ET AL.	
	<b>Examiner</b> Jeff Wollschlager	<b>Art Unit</b> 1732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,6,8,10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9,11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/17/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, claims 1, 3, 5, 7, 9, 11 and 13, in the reply filed on May 22, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 2, 4, 6, 8, 10 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Oath/Declaration***

A new oath or declaration is required because the oath filed February 17, 2004 was not executed in accordance with either 37 CFR 1.66 or 1.68. Further, the declaration filed May 15, 2006 is not proper. The requirement is that the declarants sign on the same document or alternatively the "additional inventors being named" box must be checked, as appropriate. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the current drawings are difficult to comprehend due to their informal nature. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 5, 7, 9, 11, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims require substantial revision in order to be fully examined. Positive method steps defining the active steps taken to practice the claimed method of molding the sculpture are required. Additionally, the detailed and repetitious references to the aesthetic and physical qualities of the molded sculpture add little patentable weight to the method claims. The positive and active molding steps will hold the most weight in determining the patentability of the method. An example of analogous claims defining positive method steps can be found in U.S. Patent 6,383,429 issued to Noto.

Claim 1 is indefinite because it is unclear whether the completed form of the surfer is placed in a mold followed by molding the undersea environment around the surfer or if the surfer is molded at the same time as the environment. Further, it is unclear whether the physical mold itself is painted or if the article is painted when it is removed from the mold or if the intention is for colored resin to be added to the mold to produce a colored article.

Claims 3 and 7 are indefinite because the word "tube" is recited in quotation marks. The use of quotation marks makes the claim indefinite as it is unclear what is intended. If the meaning of the word, "tube" is important for an understanding of the method of molding it should be defined appropriately without quotation marks. It is also noted that the fish-eye lens appears to add little to the claimed method steps. It is further noted that the phrase "fish-eye lens" is indefinite because it is unclear as to what is intended by the recitation of the phrase. Further, claim 7 employs the word "tube" in two apparently different senses. It is unclear which tube is being referred to throughout the claim.

Claims 5, 9, and 13 provides for the use of a fish-eye lens, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 5, 9, and 13 are also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an

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improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 11, which depends from claim 3, recites the limitation "the hollow viewing tube". There is insufficient antecedent basis for this limitation in the claim.

For the purposes of examination, claim 1, is interpreted as a method of making a sculpture comprising placing a first member made of plastic, metal or similar sturdy material of a predetermined shape into a mold cavity of a predetermined shape, filling the void space in the mold cavity with a clear resin, and curing the contents of the mold to form the sculpture. The shape of the sculpture being made has been considered in the rejection below. However, it is noted that the aesthetic and physical dimensional qualities/shapes of the molded article only hold patentable weight to the extent a contribution is made over the prior art.

Additionally, the limitations in claims 3, 5, 7, 9, 11, and 13, appear to limit the sculpture not the method of making the sculpture.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 7, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Noto (U.S. Patent 6,383,429; issued May 7, 2002).

Noto teaches a method of making a sculpture comprising placing a first three-dimensional member made of plastic/acrylic having a selected surface/predetermined shape into a mold cavity of a predetermined shape, filling the void space in the mold cavity with a clear resin, and curing the contents of the mold to form the sculpture (Abstract, col. 8, lines 16-37). The discernable positive method steps recited in the claims are met by the reference.

### ***Conclusion***

All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

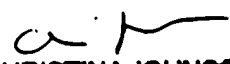
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager  
Examiner  
Art Unit 1732

May 23, 2006

  
**CHRISTINA JOHNSON**  
**PRIMARY EXAMINER**  
5/30/06